

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1, 2, 4-6 and 8-19 are pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

As a preliminary matter, Applicant submits that the finality of the July 15, 2005 Office Action is improper. The Examiner indicates that the Office Action is made final because the March 2, 2005 Amendment necessitated the new grounds of rejection in the Office Action. However, independent claims 9 and 17 were not amended in the March 20, 2005 Amendment and are now rejected based on new grounds.¹ **Accordingly, the Examiner is requested to withdraw the finality of the July 15, 2005 Office Action and enter the present Amendment.**

Claims 1, 2, 5, 6, 9, 11, 13, 15-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by newly cited Smith et al. (U.S. Patent No. 6,333,973; hereafter "Smith"). Claims 4, 8, 10, 12 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of newly cited Houde et al. (U.S. Patent No. 5,920,822; hereafter "Houde"). Applicant respectfully traverses the prior art rejections.

Independent Claims 1, 2, 5, 15 and 16

Independent claims 1, 2 and 15 recite in part:

¹ As set forth in MPEP 706.07(a), "second or any subsequent actions on the merits shall final, except where the examiner introduces a new grounds of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p)."

(b) sending to the voice mail server a user input for storing the new voice message or deleting the new or previously stored voice message stored in the voice mailbox of the voice mail server, and finishing the access to the voice mail server;

(c) when a state change in the new or previously stored voice message stored in the voice mailbox of the voice mail server occurs due to the user input sent in the step (b), receiving from the voice mail server a short message indicating the state change of the new or previously stored voice message stored in the voice mailbox of the voice mail server

Similarly, independent claims 5 and 16 recite in part:

(b) receiving a command for storing a new voice message or for deleting a new or previously stored voice message stored in the voice mailbox of the voice mail server, from the user mobile telecommunications terminal connected to the voice mail server;

(c) changing a state of the new or previously stored voice message stored in the voice mailbox of the voice mail server in accordance with the command received in the step (b); and

(d) sending to the user mobile telecommunications terminal a short message indicating the state of the new or previously stored voice message stored in the voice mailbox of the voice mail server changed in the step (c)

With regard to these features of claimed invention, the Examiner asserts Smith discloses that:

once the user reads or listens to a message, message center [of the mobile phone] marks the message as read/heard i.e., message center indicates status of the messages read/unread, or heard/unheard (read on the state changing step of the message and receiving a short message short message) [Column 8, Line 66-Column 9, Line 5].

Since the Message center operates in conjunction with network services provider as stated above modifying information step is inherent [for] Smith's message management method to store the modified message information i.e., heard and unheard message or edited message in the user's voice mail box in the voice server of network services provider.

However, Applicant respectfully submits that Smith does not disclose, either expressly or inherently, sending from the voice mail server to the user mobile telecommunications terminal a

short message indicating the state change, due to a user input at the user mobile telecommunications terminal, of the new or previously stored voice message stored in the voice mailbox of the voice mail server.

Smith discloses that when a voice mail message is received and stored at the voice mailer server 5600, an SMS voice mail notification message is sent to the mobile telephone 1100 by the voice mail server 5600 (via SMS server 5300) to notify the user of the voice mail message. In response to the notification message, a message center 6100 of the mobile telephone 1100 updates and presents a list of messages received and an indication of the total number of messages received (see Fig. 7A). When a user establishes a connection to the voice mail server 5600 from the mobile telephone 1100, the message center 6100 provides graphical controls (e.g., play, skip, delete, etc.) for interacting with the voicemail server (see Fig. 10, and column 9 line 35 - column 10, line 2). When a user presses one of the graphical controls, the mobile telephone 1100 translates the user's action into corresponding DTMF tones to control the voice mail server 5600. Once the user listens to a voice mail message, the message center 6100 marks the message as heard using a discernable mark (i.e., a check mark) to indicate to the user that the message has been heard.

Accordingly, nowhere does Smith teach or suggest that after the voice mail server has stored or deleted a new or previously stored voice message in response to a user input, the voice mail server sends to the mobile telephone a short message indicating the state change due to the user input. Further, there is no teaching or suggestion in Smith that would lead one of ordinary skill in the art to believe this feature of the claimed invention is inherent in Smith's system. That

is, similar to the conventional systems discussed in the “Background of the Invention” section of the present application, Smith only discloses notifying the mobile phone that a new message has been received at the voice mail server. Smith does not disclose whether the list of received messages or the indication of the total number of received messages maintained and presented by the message center of the mobile phone is modified when a message is deleted or stored at the voice mail server due to a user input.

It is well settled that if an element is inherently described by the prior art, “it must be necessarily present and a person of ordinary skill in the art would recognize its presence.” *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923, 289 F.3d 1367, 1377 (Fed. Cir. 2002). Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* However, as discussed above, Applicant respectfully submits that it is quite clear that the voice mail server of Smith does not necessarily send to the mobile telephone a short message indicating the state change due to a user input for storing or deleting a new or previously stored voice message.

Accordingly, Applicant respectfully submits that independent claims 1, 2, 5, 15 and 16, as well as dependent claims 4, and 6-8, should be allowable because the cited reference does not teach or suggest all of the features of the claims.

Independent Claims 9 and 17

By this Amendment, Applicant has amended independent claims 9 and 7 to recite in part:

(a) changing a state of a new or previously stored voice message stored in a voice mailbox of the voice mail server in accordance with a command received from a user mobile telecommunications terminal;

(b) forming a Short Message Service (SMS) message including an indication of the state of the new or previously stored voice message stored in the voice mailbox of the voice mail server changed in the step (a), and a message identifier of the new or previously stored voice message stored in the voice mailbox of the voice mail server; and

(c) sending the short message formed in the step (b), including the message identifier and the indication, to the user mobile telecommunications terminal from the voice mail server.

With regard to claims 9 and 17, the Examiner asserts that “Smith clearly discloses that [the] notification message might include the caller's name and telephone number, a time and date stamp, and the name and address of voice mail server (inherently reads on assigning a message identifier step and storing the message identifier with the new voice message in order to identify the stored voice message)”. However, Applicant respectfully submits that Smith does not teach or suggest forming and sending a Short Message Service (SMS) message including an indication of a state of a new or previously stored voice message stored in the voice mailbox of the voice mail server changed in response to a command received from a user mobile telecommunications terminal, and a message identifier of the new or previously stored voice message stored in the voice mailbox of the voice mail server.

Accordingly, Applicant respectfully submits that independent claims 9 and 17 should be allowable because the cited reference does not teach or suggest all of the features of the claims.

Independent Claims 11, 13, 18 and 19

Independent claims 11 and 18 recite in part:

(b) modifying information of the new or previously stored voice message stored in the voice mailbox of the user mobile telecommunications terminal, according to the user input modifying information received in the step (a);

(c) forming an SMS message notifying the voice mail server of the modification of the information regarding the new or previously stored voice message stored in the voice mailbox of the user mobile telecommunications terminal; and

(d) sending the SMS message, formed in the step (c), notifying the voice mail server of the modification of the information regarding the new or previously stored voice message stored in the voice mailbox of the user mobile telecommunications terminal.

Independent claims 13 and 19 recite in part:

(a) receiving an SMS message indicating a modification of information of a new or previously stored message stored in a voice mailbox of a user mobile telecommunications terminal from the user mobile telecommunications terminal; and

(b) changing a state of the new or previously stored voice message stored in the voice mailbox of the user mail server, according to the modification of the information of the voice message stored in the voice mailbox of the user mobile telecommunications terminal, which was notified through the SMS message received in the step (a).

The Examiner asserts that:

Smith discloses that user is enabled to access the user's voice mail box in voice mail server 5600 using the graphical controls [Figure 10] [Column 9, Line 54-65], receiving the pending messages (reads on a new or previously stored voice message stored in a voice mailbox of the voice mail server). Smith also discloses that the user is enabled to view the different types of pending messages such as fax mail, email, voice mail, etc and enabled the user to view, prioritize, edit, playback, discard, and/or forward messages [Column 3, Line 48-59] stored in the voice mail server (reads on modifying information step). Smith also discloses that the user of the mobile telephone is capable of sending SMS messages via SMS server [Figure 3] [Column 5 Column 8, Line 1-10]. Therefore, forming a short message Step (c) and sending the short message step (d) are inherent since user's mobile terminal would have sent the network services provider a SMS message via Message center and SMS server to the voice server to request the user editing to the identified message stored in the user voice mail box of the voice server.

However, as discussed above, Smith discloses that the message center 6100 of the mobile telephone 1100 provides graphical controls (e.g., play, skip, delete, etc.) for interacting with the voicemail server (see Fig. 10, and column 9 line 35 - column 10, line 2) while a connection has been established to the voice mail server, and that when a user presses one of the graphical controls, the mobile telephone 1100 translates the user's action into corresponding DTMF tones to control the voice mail server 5600. Nowhere does Smith teach or suggest sending an SMS message, from the mobile telephone to the voice mail server, notifying the voice mail server of a modification of information of a new or previously stored message stored in a voice mailbox of a user mobile telecommunications terminal. Moreover, Smith does not teach or suggest that the mobile telephone transmits any SMS messages to the voice mail server. Instead, Smith simply teaches that the mobile telephone may respond to the message sender (i.e., the calling party) by sending an SMS message.

Further, there is no teaching or suggestion in Smith that would lead one of ordinary skill in the art to believe this feature of the claimed invention is inherent in Smith's system. That is, similar to the conventional systems discussed in the "Background of the Invention" section of the present application, Smith only discloses notifying the mobile phone that a new message has been received at the voice mail server. Thus, Applicant respectfully submits that it is quite clear that Smith's mobile phone does not necessarily send an SMS message to the voice mail server notifying the voice mail server of a modification of information of a new or previously stored message stored in a voice mailbox of a user mobile telecommunications terminal.

AMENDMENT UNDER 37 C.F.R. § 1.116
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Accordingly, Applicant respectfully submits that independent claims 11, 13, 18 and 19, as well as dependent claims 12 and 14, should be allowable because cited reference does not teach or suggest all of the features of the claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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